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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,471	08/24/2000	Masaya Yukinobu	000996	4323

38834 7590 03/09/2004

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EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/645,471	Applicant(s) YUKINOBU ET AL.	
	Examiner Kevin R Kruer	Art Unit 1773	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☒ The proposed amendment(s) will not be entered because:
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 13-20 and 22-25.

Claim(s) withdrawn from consideration: 1-12 and 21.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
 10. ☐ Other: _____

Advisory Action

Applicant's arguments filed February 10, 2004 have been fully considered, but are not persuasive. Furthermore, the proposed amendment filed February 10, 2004 will not be entered because it would raise new issues that would require further search and/or consideration. Specifically, the proposed amendment to the transitional phrase from "consisting essentially of" to "consisting" would significantly narrow the scope of the claim and would require a further search.

Applicant argues that the in light of the prosecution history of the present application, the amendment filed with the Request for Continued Examination on July 30, 2003, could not have been finally rejected on the grounds and art of record because the amendment of "comprising" to "consisting essentially of" and the added limitation "the transparent coating layer is capable of transmitting visible light" materially affected the scope of the claim. The examiner respectfully disagrees.

As explained in MPEP 2111.03, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." In the present application, there was no such indication or any indication that the additional components included in the prior art materially affected the "basic and novel characteristics" of the claimed coating liquid. Furthermore, MPEP 2111.03 states that applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention if an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of."

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Applicant presented no such showing. Thus, the amendment did not materially affect the scope of the claim.

Furthermore, the examiner takes the position that the newly added limitation stating "the transparent coating layer is capable of transmitting visible light" did not materially affect the scope of the claim because the claim previously stated that the coating was transparent. Transparency is defined as the ability to transmit light. Thus, the new limitation did not alter the scope of the claim.

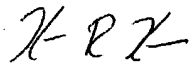
Applicant's arguments with respect to the 35 U.S.C. 112, first paragraph rejection and the rejection under 35 U.S.C. 102 based upon the teachings of Marcantonio have been fully considered. However, the arguments are based upon the proposed amendment. Since the proposed amendment will not be entered for the reasons stated above, Applicant's arguments are moot.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

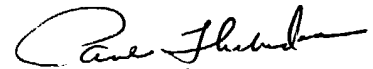
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700